



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,101	09/18/2003	Peter M. Bonutti	780-A03-040-8	7131

33771 7590 07/06/2004

PAUL D. BIANCO: FLEIT, KAIN, GIBBONS,
GUTMAN, BONGINI, & BIANCO P.L.
601 BRICKELL KEY DRIVE, SUITE 404
MIAMI, FL 33131

EXAMINER

SMITH, RUTH S

ART UNIT	PAPER NUMBER
----------	--------------

3737

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

42

Office Action Summary	Application No. 10/666,101	Applicant(s) BONUTTI, PETER M.	
	Examiner Ruth S Smith	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Specification

The disclosure is objected to because of the following informalities: On page 1, applicant should update the status of the continuing data. Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

Claims 4-6,8,9,11,12,14,15,17,18 are objected to because of the following informalities: In claim 4, line 5, "lowering" is misspelled. Claims 8,9,11,12,14,15,17,18 are objected to because it is unclear as to what further structural limitations have been set forth. The various parts of the body are not positively set forth as part of the claimed invention. Therefore, how these body parts are affected fail to impose any further limitations on the claimed invention. It is unclear as to whether applicant is attempting to include these body parts as part of the claimed invention. It should be noted that such inclusion would render the claims non-statutory. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 3,6,21,24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to disclose that the system includes a secondary electromagnet.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,4,19,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Damadian (4,411,270) in view of Matsutani. Damadian discloses a method and apparatus for providing magnetic resonance imaging wherein the patient is positioned in a vertical orientation. If a small child were being imaged the system would be capable of imaging a patient in a seated or standing position. In the absence of any showing of unexpected results, whether the patient is seated or standing, as long as they are oriented vertically, would have been a matter of ordinary engineering design choice. Damadian discloses that in addition to moving the patient, one can instead move the imaging volume 44. Matsutani discloses a MRI system with means for positioning the patient such that a desired portion of the patient is imaged. Such means includes an actuator for raising or lowering the patient support to properly position the patient. It would have been obvious to one skilled in the art to have modified Damadian such that it includes an actuator for raising or lowering the patient in order to properly position the patient such that the imaging volume is placed within a desired body portion.

Claims 2,5,20,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Damadian (4,411,270) in view of Matsutani as applied to claims 1,4,19,22 above, and further in view of Shah. Shah discloses an MRI system which includes the use of a positioning fixture to maintain the patient in a fixed position during imaging. It would have been obvious to one skilled in the art to have further modified Damadian such that it includes a positioning fixture to maintain the patient in a fixed position during imaging. The advantage of such is to ensure proper placement of patient during imaging.

Claims 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Damadian (4,411,270) in view of Matsutani and Shah. Damadian discloses a method and apparatus for providing magnetic resonance imaging wherein the patient is

positioned in a vertical orientation. If a small child were being imaged the system would be capable of imaging a patient in a seated or standing position. In the absence of any showing of unexpected results, whether the patient is seated or standing, as long as they are oriented vertically, would have been a matter of ordinary engineering design choice. Damadian discloses that in addition to moving the patient, one can instead move the imaging volume 44. Matsutani discloses a MRI system with means for positioning the patient such that a desired portion of the patient is imaged. Such means includes an actuator for raising or lowering the patient support to properly position the patient. It would have been obvious to one skilled in the art to have modified Damadian such that it includes an actuator for raising or lowering the patient in order to properly position the patient such that the imaging volume is placed within a desired body portion. Shah discloses an MRI system which includes the use of a positioning fixture to maintain the patient in a fixed position during imaging. It would have been obvious to one skilled in the art to have further modified Damadian such that it includes a positioning fixture to maintain the patient in a fixed position during imaging. The advantage of such is to ensure proper placement of patient during imaging. With respect to claims 8,9,11,12,14,15,17,28, there are inherently forces that the body is subjected to and the forces of gravity will be greater than the upward forces applied by the support. It should be noted that the system of Damadian can be applied to image any body portion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S Smith whose telephone number is (703) 308-3063. The examiner can normally be reached on M-F 5:30 AM- 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ruth S. Smith', with a stylized, cursive script.

Ruth S Smith
Primary Examiner
Art Unit 3737

RSS